

REMARKS

In connection with Applicants' Request for Continued Examination (RCE), Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.114, and in light of the remarks which follow.

Claims 26, 28-50, 53, 54 and 116 are pending in the application, claims 51, 56-81, 83, 84, 86-111, 113-115, and 117-120 having been canceled above.

By the above amendments, claim 116 is amended to recite, in part, "... having such amount of substance P already released therein by exposure to and contact with at least one substance P-releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P, and said at least one substance P antagonist being formulated into a topically applicable, cosmetically/dermatologically acceptable medium therefor." Additionally, claims 26, 28-32, 34-37, 40, 45-49 and 53 are amended to depend from independent claim 116. All of the remaining pending claims have been canceled.

Applicants thank the Examiner for the courtesies extended to their representative, Martin A. Bruehs, during the personal interview on June 8, 2004. In particular, Applicants thank the Examiner for indicating that favorable consideration would be given to Applicants' further amendments and remarks in connection with this application.

Turning now to the Official Action, claims 26, 28-51, 53, 54, 56-81, 83, 84, 86-111 and 113-120 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

Applicants note that the Official Action indicates that independent claims 115-120 are unclear as to what Applicants' intend to convey by "eliminate the release of substance P." In order to clarify Applicants' intention, Applicants have amended claim 116 and canceled the remaining independent claims. In particular, Applicants have amended claim 116 to recite "... an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P"

Accordingly, Applicants respectfully request reconsideration and withdrawal of the §112, second paragraph, rejection.

Claims 26, 28, 32-34, 45, 46, 51, 56-58, 62-64, 75, 76, 86-88, 97, 101, 105, 106, 111 and 113-120 stand rejected under 35 U.S.C. §102(b) as being anticipated by WO 93/14084. As independent claims 115, 117, 118, 119 and 120 have been canceled and because independent claim 116 has been amended, Applicants submit that the rejection is now moot. However, in an effort to expedite prosecution of the application, Applicants provide the following remarks with respect to amended independent claim 116.

Independent claim 116, as amended above, recites a cosmetic or dermatological method for treating sensitive skin of an individual in need of such treatment, said sensitive skin having such amount of substance P already released therein as to cause neurogenic manifestations of dyesthesia caused by the release of substance P therein, said sensitive skin being characterized by exhibiting at least one symptom selected from the group consisting of tingling, prickly, itching, pruritus, overheating, discomfort, tugging sensations, desquamation and erythema; said method comprising topically applying to said sensitive skin having such amount of

substance P already released therein by exposure to and contact with at least one substance P-releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P, and said at least one substance P antagonist being formulated into a topically applicable, cosmetically/dermatologically acceptable medium therefor.
(Emphasis added.)

It is well established that in order to demonstrate anticipation under 35 U.S.C. §102(b), each element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 218 USPQ 789 (Fed. Cir. 1983). That is not the case here.

For example, WO '084 fails to disclose or fairly suggest a cosmetic or dermatological method for treating sensitive skin that includes topically applying to said sensitive skin having such amount of substance P already released therein by exposure to and contact with at least one substance P-releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of already released substance P, as defined in independent claim 116.

Accordingly, Applicants submit that WO '084 fails to expressly or inherently describe each element of the claims in issue, and therefore fails to anticipate claim 116.

For at least these reasons, claim 116 is patentable over WO '084. Because the remaining claims (26, 28-50, 53 and 54) depend, either directly or indirectly, from independent claim 116, the remaining claims are therefore also patentable over WO '084 for at least the reasons that claim 1 is patentable.

Claims 26, 28, 32-34, 45, 46, 51, 56-58, 62-64, 75, 76, 86-88, 97, 101, 105, 106, 111 and 113-120 stand rejected under 35 U.S.C. §103 as being unpatentable over WO '084. As independent claims 115, 117, 118, 119 and 120 have been canceled and because independent claim 116 has been amended, this rejection is now moot. However, in an effort to expedite prosecution of the application, Applicants provide the following remarks concerning independent claim 116.

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385; 165 USPQ 494, 496 (CCPA 1970). See M.P.E.P. §2143.03.

As explained above, Applicants submit that WO '084 fails to teach or suggest all of the claim elements. That is, because WO '084 fails to teach or suggest a cosmetic or dermatological method for treating sensitive skin by topically applying to said sensitive skin having such amount of substance P already released therein by exposure to and contact with at least one substance P-releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance, WO '084 does not teach or suggest all of the elements of independent claim 116.

Furthermore, WO '084 does not reflect a proper consideration of "all words" in the claim. In particular, because WO '084 does not teach or suggest a method comprising topically applying to sensitive skin having an amount of substance P already released therein by exposure to and contact with at least one substance P-

releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P, Applicants submit that the rejection over WO '084 does not give full consideration to all of the claim elements, i.e., patentable weight must be given to "having such amount of substance P already released therein," "by exposure to and contact with at least one substance P-releasing active agent," and "an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P," in claim 116 in judging the patentability of claim 116 over WO '084.

For at least these reasons, claim 116 is patentable over WO '084. In addition, as explained above because the remaining claims depend, directly or indirectly from independent claim 116, the remaining claims are also patentable over WO '084 for at least the reasons that claim 116 is patentable.

Claims 26, 28-51, 53, 54, 56-81, 83, 84, 86-111 and 113-120 stand rejected under 35 U.S.C. §103 as being unpatentable over Wallengren (Contact Dermatitis), Wallengren (BR. J. Dermatitis) in combination with WO 83/01252 and/or WO 93/14084. As Applicants have canceled independent claims 115, 117, 118, 119 and 120 and because claim 116 has been amended, Applicants submit that this rejection is now moot. However, in an effort to expedite prosecution of the application, Applicants provide the following remarks.

As explained above, in order to establish a *prima facie* case of obviousness, it is necessary to demonstrate that the prior art references (or references when combined) teach or suggest all of the claim elements. See In re Royka. Additionally, "all words in a claim must be considered in judging the patentability of that claim against the prior art." See In re Wilson and M.P.E.P. §2143.03.

Applicants submit that a *prima facie* case of obviousness has not been established in view of the above-asserted combination of references. That is, Applicants submit that the above-asserted combination does not teach or suggest all of the elements of independent claim 116. Specifically, the above-asserted combination does not disclose or suggest a cosmetic or dermatological method for treating sensitive skin by topically applying to the sensitive skin having an amount of substance P already released therein by exposure to and contact with at least one substance P-releasing active agent, an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P. Additionally, the above-asserted combination does not reflect a proper consideration of "all words" in claim 116. That is, the words "having such amount of substance P already released therein," "by exposure to and contact with at least one substance P-releasing active agent," and "an amount of at least one substance P antagonist effective to reduce or eliminate such amount of said already released substance P," must be considered in judging the patentability of claim 116 over the combination of Wallengren (Contact Dermatitis), Wallengren (BR. J. Dermatitis) in combination with WO '252 and/or WO '084.

For at least these reasons, claim 116 is patentable over the combination of Wallengren (Contact Dermatitis), Wallengren (Br. J. Dermatitis) in combination with WO '252 and/or WO '084. In addition, as the remaining claims depend, directly or indirectly, from independent claim 116, Applicants submit that these claims are also patentable over the above-asserted combination for at least the reasons that claim 116 is patentable.

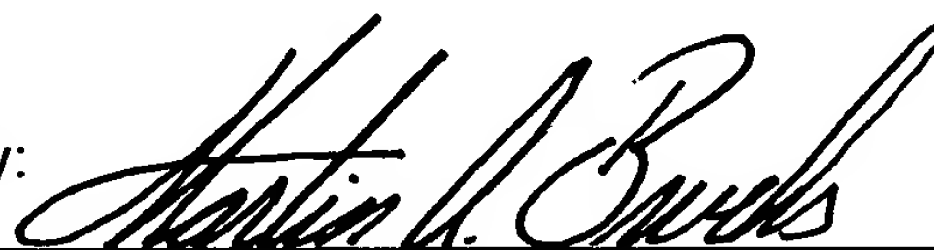
From the foregoing, Applicants earnestly solicit further and favorable action in the form of a notice of allowance. If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 23, 2004

By:

A handwritten signature in black ink, appearing to read "Martin A. Bruehs", written over a horizontal line.

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